

### **REMARKS**

Currently claims 1, 2, 4-7, 9-12, 27 and 29-36 are pending in the application and claims 1, 2, 4-7, 9-12, 27 and 29-36 have been rejected.

By this amendment, applicants have amended the independent claims to indicate that a particular user is identified and that the affective information is included in the image file. New claim 37 has been added.

There are three independent claims in this case, claims 1, 7 and 29. Claim 1 is believed to be representative and the following discussion is also applicable to not only claim 1 but also claims 7 and 29.

Claims 1, 2, 4-7, 9-12, 27 and 29-36 were rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

The rejection under 35 U.S.C. § 101 is traversed.

Applicants would like to point out to the Examiner that an image file that stores data, is a physical thing that actually exists. The present invention is concerned with forming a digital file that has data in the form of three elements stored in the file that have a functionality and is not the equivalent of printed subject matter. The present invention is clearly useful in enabling the user identified in the image file, to retrieve particular important images. The Examiner's attention is called to the State Street Bank & Trust Co. v. Signature Financial Group, Inc. 149 F.3d 1368, 47 USPQ 2d 1596 (Fed. Cir.), cert. Denied, 119 S. Ct. 336 (1998). In this case, the court held "Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete and tangible result'--a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades..." (underlining added). This case stands for the proposition that "a useful, concrete and tangible result" renders a claim statutory subject matter. Clearly, the present invention, as set forth in claim 1 and all the other independent claims, is useful, concrete, and provides a tangible result, which permits retrieval of important images. Since the claims in this case are useful and not directed to claiming text in a book, but to forming an image file which has utility in that it permits the retrieval of important images.

Applicants believe that all of the claims in this case are clearly statutory and set forth subject matter that is unobvious as will later be described.

Claims 1, 6-7, 9-12, 27 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shepard et al., hereinafter Shepard(US Pub. No. 2003/0191682) in view of Microsoft Press Computer Dictionary et al., hereinafter Microsoft Dictionary.

Shepard relates to a computer-implemented positioning system for perception management, where the system provides a technique for collecting and analyzing information that may be used to create an image or perception for a product or company. For example, a company wanting to create a particular image of being “fun and exciting” can use the positioning system for collecting information about what users think is “fun and exciting.”

There is no teaching, motivation, or suggestion in Shepard for elements b) and c) of claim 1. The Examiner cites paragraph [0012] of Shepard as describing an importance rating of digital image. The description in this paragraph is a rambling discussion of how a company may establish a position in the marketplace. Clearly, there is no suggestion of elements b) and c) in this paragraph.

The Examiner also cites paragraph [0120] that states “Referring to FIGS. 15-20, classification information of the outputted particular visual representations 2338 is rated and the ratings are then processed to determine an average rating 2352 for each outputted visual representation 2338. Also, the ratings of the classification information may be processed to identify a ranking of one or more of the outputted visual representations 2338.”

This paragraph is concerned with determining ratings by a plurality of different persons of a plurality of different visual representations. There is no way that the database of Shepard can be used by a particular user to retrieve images of importance to that particular user.

The Examiner cites the Microsoft reference that defines “database” as “A file composed of records, each containing fields together with a set of operations for searching, sorting, recombining and other functions.” The Examiner’s position appears to be that anything stored in a database is the same as an image file. However, an image file is not a file in the broadest sense of the word as defined in the Microsoft Dictionary. For example, an image file does not

contain any operations. It contains an image and associated metadata. The image file can be separately transferred from one computer to another, and the associated metadata in the image file can be used to assist in retrieving the image contained in the file. Thus, applicants believe that there is a difference between an image file and a database. In any event, the elements b) and c) in the independent claims are nowhere to be found in Shepard.

Claims 2 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shepard as applied to claim 1 above, further in view of Microsoft Dictionary, and further in view of Boyel et al. (US Pub. No. 2001/0041021)

Claims 2 and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shepard as applied to Claim 1 above, and further in view of U.S. Publication No. 2001/0041021 A1 to Boyle et al. (hereinafter Boyle). This rejection is respectfully traversed. Applicants submit that Claims 2 and 5, which depend from Claim 1, are allowable for at least the same above-discussed reasons that Claim 1 is allowable.

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shepard as applied to claim 1 above, further in view of Microsoft Dictionary, and further in view of Szajewski et al. (US Pat. No. 6,222,607).

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shepard as applied to Claim 1 above, and further in view of U.S. Patent No. 6,222,607 B1 to Szajewski et al. (hereinafter, Szajewski). Applicants submit that Claim 4, which depends from Claim 1, are allowable for at least the same above-discussed reasons that Claim 1 is allowable.

Claims 30 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shepard as applied to claim 1 above, further in view of Microsoft Dictionary, and further in view of Engeldrum et al. (US Pat. No. 6,847,376)

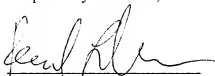
Claim 32 was rejected as being unpatentable over Shepard and Microsoft Dictionary as applied to claim 1 and further in view of Stokes et al. (US Pub. No. 2001/0033286). Claim 33 was rejected as being unpatentable over Shepard and Microsoft Dictionary and Stokes as applied to claim 32 and further in view of Sandstrom et al. (US Pat. No. 5,619,571).

TIFF and JPEG files are well known. Nevertheless, these claims all depend from claim 1 and should be allowed for the reasons set forth above.

It is believed that these changes now make the claims clear and definite and, if there are any problems with these changes, Applicants' attorney would appreciate a telephone call.

In view of the foregoing, it is believed none of the references, taken singly or in combination, disclose the claimed invention. Accordingly, this application is believed to be in condition for allowance, the notice of which is respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Raymond L. Owens', written over a horizontal line.

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.